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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/021,494

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Jesse Donaldson

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08/26/2008

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EXAMINER

LEE, WILSON

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/021,494	Applicant(s) DONALDSON ET AL.	
	Examiner Wilson Lee	Art Unit 2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

Applicant's arguments filed on 7/17/08 have been fully considered but they are not persuasive.

Applicant argues that Mills fails to disclose "automatically copying said file from a memory of said portable electronic device to said removable memory" which are found in Claims 33, 39, 45, 51. As alleged by applicant, downloading information Internet to an expansion card in Mills is very different from the copying a file from a memory of a portable electronic device to a removable memory because the Internet in Mills is not a memory of a portable electronic device as recited in paragraph 0078 of Mills.

Examiner is not persuaded.

In paragraph 0078 of Mills, Mills teaches one of the applications for use with a PDA and a digital cell phone, wherein the expansion card provides the PDA with a modem and a comm link for coupling to the cell phone. Internet is merely an intermediate medium for transferring or exchanging files and data between terminals. The files, that are downloaded to the expansion card, for instances, are emails, MP3 audio, streaming video, must be created or uploaded from another terminal or computing device. Internet itself cannot create any emails, MP3 audio, or streaming video. Thus in Mills, the files being copied are not originally from Internet, but from another terminal.

It is noted that Mills teaches the terminals being used in this specific application are PDA and cell phone, which are portable.

Further, in paragraph 0046, lines 9-11, Mills teaches “transferring the digitally encoded media from the PDA to the expansion card, storing the digitally encoded media from the expansion card to the removable memory”. It teaches that the files are copied from the portable PDA to the expansion card. It is noted that PDA, expansion card, and the removable memory are all portable devices.

Claim Rejections – 35 U.S.C. 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 33, 34, 39, 40, 45, 46, 51, 52, 56, 57 are rejected under 35 U.S.C. 102(e) as being anticipated by Mills et al. (US 2004/0048503), a continuation of 09/439,966.

Regarding Claim 33, Mills et al discloses a method of copying files comprising:
storing a plurality of location identifiers comprising a location identifier of a removable memory (inherently storing the identifiers or indexes of the files for retrieval)

(See Response in Argument #1 in the previous office action dated in 4/17/08 for explanation), said removable memory detachably coupled to a portable electronic device (page 3, paragraphs 0035-0038),

in response to a user selection of a file to copy to said removable memory, associating said location identifier of said removable memory with said file (See paragraph 0035 lines 12-24, paragraph 0046 lines 16-21, paragraphs 0078, 0159 lines 11-16 and Response in Argument #2 in the previous Office Action dated 4/17/08 for explanation), and

in response to said associating, automatically copying said file from a memory of said portable electronic device (paragraph 0046) to said removable memory (See paragraphs 0045, 0046 and the Response in the Argument #2 in the Final Rejection dated 10/31/07 for explanation).

Regarding Claim 34, Mills et al discloses removable memory is at least one of SD (Secure digital) card ("private removable media/memory", line 12 of paragraph 0033), a MMC ("MMC", line 6, paragraph 0133), a Compact Flash card ("Compact Flash Card", line 2 of paragraph 0010; "removable flash-based memory", line 1 of paragraph 0159) and a Smart Media card ("Smart Cards, SIM Cards", line 8 of paragraph 0175). (Also see paragraphs 0044, 0051, 0052, 0057, 0058 for details).

Regarding Claims 39, 45, 51, 56, these claims are rejected on grounds corresponding to the arguments and rejection given above for rejected claim 33 is similarly rejected.

Regarding Claims 40, 46, 52, 57, these claims are rejected on grounds corresponding to the arguments and rejection given above for rejected claim 34 is similarly rejected.

Claim Rejections – 35 U.S.C. 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 35-38, 41-44, 47-50, 53-55, 58-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mills et al. (US 2004/0048503), a continuation of 09/439,966, in view of Payne et al. (USP 7,003,327).

Regarding Claims 35-37, Mills teaches “PDA’s display/input-tablet provides for virtual controls and visual indicators for the application” (paragraph 0147) and “perform O/S related functions in conjunction with expansion modules” (paragraph 0149).

Although Mills does not literally disclose displaying said plurality of location identifiers comprising texts or icons, Payne (7,003,327) teaches a mobile device (Col. 3, line 55 to Col. 4, line 4) embodying an advantage such as displaying the identifiers for retrieving information (the word “retrieving” indicates the information has been stored). Payne also discloses, for instances, email contact identifiers (in text) (Col. 11, lines 13-20), and visual identifiers (in icons) (272, 274, 276, 278, 280, 284, 270) on the display of the cell phone (in Figure 2G). Further, since Payne displays the identifiers, such identifiers are also at least stored in the RAM before being displayed.

It would have been obvious to one of ordinary skill in the art to provide identifiers or icon as location identifiers in the PDA, digital cell phone or handheld device using with the expansion card of Mills in order to provide advantageous convenient way for user as taught by Payne to select the files for retrieval or storage. Such “displaying a plurality of location identifiers...” would have given those skilled in the art the tools to process issues regarding portable devices more efficiently. This gives user the advantage of copying data to the proper more accurately.

Regarding Claim 38, Mills teaches “PDA’s display/input-tablet provides for virtual controls and visual indicators for the application” (paragraph 0147) and “perform O/S related functions in conjunction with expansion modules” (paragraph 0149).

Although Mills does not literally disclose displaying a visual indicator associated with files, Payne (7,003,327) teaches a mobile device (Col. 3, line 55 to Col. 4, line 4) embodying an advantage such as displaying the identifiers for retrieving information (the word “retrieving” indicates the information has been stored). Payne also discloses, for instances, icons identifiers (272, 274, 276, 278, 280) and other identifiers (284, 270) on the display of the cell phone (in Figure 2G) for users to choose. Further, since Payne displays the identifiers, such identifiers are also at least stored in the RAM before being displayed.

It would have been obvious to one of ordinary skill in the art to provide icon identifiers as visual indicators display in the PDA, digital cell phone or handheld device using with the expansion card of Mills in order to provide advantageous convenient way for user as taught by Payne to select the files for retrieval or storage. Such “visual

indicator” would have given those skilled in the art the tools to process issues regarding portable devices more efficiently. This gives user the advantage of copying data to the proper more accurately.

Regarding Claims 41-43, 47-49, 53-54, 58, 59, these claims are rejected on grounds corresponding to the arguments and rejections given above for rejected claims 35-37 are similarly rejected.

Regarding Claims 44, 50, 55, 60, these claims are rejected on grounds corresponding to the arguments and rejection given above for rejected claim 38 is similarly rejected.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Wilson Lee whose telephone number is (571) 272-1824.

Papers related to the application may be submitted by facsimile transmission. Any transmission not to be considered an official response must be clearly marked "DRAFT". The official fax number is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

8/25/08

/Wilson Lee/
Primary Examiner, Art Unit 2163